

Application No.: 10/757,266
Attorney Docket No. 030901 / SI.0029.US01
Response to Office Action Dated November 23, 2008

REMARKS

Claims 1-46 are pending in this application. Claims 1-14 and claims 33-46 have been withdrawn pending rejoinder should subsequent linking claims be allowed. Claims 15-32 stand rejected. Claims 15-17 and 29-31 have been amended to correct matters of form. New claims 47-49 have been added. The amendments and new claims find support in the specification and the prior claims; thus, no new matter is added. All amendments are made without prejudice or disclaimer. Applicants respectfully traverse the rejections for the reasons expressed herein below.

A. **Rejection of claims 15 and 16 under 35 U.S.C. § 112, second paragraph**

In claims 15 and 16, the phrases "to form (polysaccharide) fragments" and "to form the agitating media" are rejected to as being assertedly indefinite. Although Applicants assert that the claims are definite as presented, the claims are herein amended to expedite prosecution. Specifically, the claims have been amended to recite the substantively equivalent and non-limiting phrase "wherein the fragments form an agitating media" as found acceptable in claim 28. Thus, Applicants respectfully request withdrawal of the rejection.

B. **Rejection of claims under 35 U.S.C. § 103(a)**

As an initial matter, Applicants note that the Declaration of George Koutlakis ("Koutlakis Declaration," attached) addresses the central argument of the obviousness rejections, which is whether there is any motivation to combine the cited references.

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Applicants posit that one of skill in the art would not be motivated to combine the teachings regarding polysaccharide blasting media with those regarding non-polysaccharide agitating media. The rejections are all based on the premise that one of skill in the art would be motivated to combine the teachings of United States Patent No. 6,159,257 to Koutlakis *et al.* (hereinafter, Koutlakis) and/or of United States Patent No. 5,367,068 to Lane *et al.* (hereinafter, Lane), which disclose glass-like polysaccharides but not the size, and the teachings of U.S. Patent Application No. 2001/0027623 (hereinafter, Rosenflanz) and U.S. Patent No. 6,491,239 Blanton *et al.* (hereinafter, Blanton) collectively disclosing agitating media and particle sizes but not polysaccharide materials. As discussed in the Koutlakis Declaration, no one of ordinary skill in the art would be motivated to combine such teachings. To summarize, the following arguments are made under 35 USC § 103(a):

I) Claims 15-32 are rejected under 35 U.S.C. § 103(a) as assertedly being obvious over Koutlakis in view of Rosenflantz and Blanton. Applicants assert that there is no motivation to combine these references, and, thus, the rejections should be withdrawn as to all claims.

II) Claims 15, 17, 18, 20, 22, 24, 26, and 28-32 are rejected under 35 U.S.C. § 103(a) for assertedly being obvious over Lane in view of Rosenflantz and Blanton. Similarly, Applicants assert that there is no motivation to combine these references, and, thus, the rejections should be withdrawn as to all claims.

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III) Claims 16, 19, 21, 23, 25, and 27-32 are rejected under 35 U.S.C. § 103(a) for assertedly being obvious over Lane, in view of Koutlakis, and further in view of Rosenflantz and Blanton. As discussed, Applicants assert that there is no motivation to combine these references, and, thus, the rejections should be withdrawn as to all claims.

There is no motivation to combine the cited references in any of the obviousness rejections (I-III, *supra*) because obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP § 2143.01. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

As acknowledged by the Examiner in the previous Office Actions, Koutlakis and Lane disclose only polysaccharide blasting media and are silent as to the size of the claimed particles. Accordingly, it is submitted that the rejections therefore rest solely on the assertion that because the glass-like polysaccharide of Koutlakis and Lane could be abrasive, these polysaccharides are suitable in agitating applications, because, assertedly, one of ordinary skill in the art would be motivated to take blasting media and increase the size to become agitating media.

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However, there is no teaching in any document cited in the office action that stands for the proposition that blasting media can be modified to become agitating media. As such, a suggestion or motivation to combine the references is not present. Instead, the argument rests entirely on what one of skill in the art would "implicitly" acknowledge. As stated by the Federal Circuit, "[w]ith respect to core factual findings in a determination of patentability, ... [the Patent Office] cannot simply reach conclusions based on its own understanding or experience—or its assessment of what would be basic knowledge or common sense. Rather, the [Patent Office] must point to some concrete evidence in the record to support these findings." (*In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693 (Fed. Cir. 2001). Thus, since the Office Action has not recited any concrete evidence in the record, the obviousness rejections cannot stand.

As support of their position, the applicants cite to the attached Koutlakis Declaration that demonstrates that those of ordinary skill in the art would not be motivated to modify blasting media to become agitating media. The Koutlakis Declaration states:

Based upon my understanding of the field of polysaccharides, which include applications for using the same, one of ordinary skill in the art would not be motivated to use the information disclosed in Koutlakis or Lane to arrive at the agitating media claimed in the pending application. It is my opinion that the blasting medium described in Koutlakis and Lane could not be used as an agitating medium since it would clump too much to be used in such a manner. Also, large glass-like polysaccharides could not be used in blasting applications because the hard pellets would destroy the substrate.

Thus, based on the Koutlakis Declaration, and for reasons clearly made of record, there is no objective reason to combine the teachings of the references cited in

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the office action because the disclosures of Lane and Koutlakis both suggest to one of skill in the art that glass-like polysaccharides are employed only for blasting and, unlike the present claims, are simply unsuitable for milling and agitating applications.

Moreover, the proposed modifications in the rejections render the cited art unsatisfactory for its intended purpose, which is per se improper as stated in the MPEP § 2143.01(V). Specifically the MPEP states that "[i]f a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." The Koutlakis Declaration unequivocally states that "large glass-like polysaccharides could not be used in blasting because the pellets would destroy the substrate." Moreover, as presented in the Koutlakis Declaration, the blasting compositions as disclosed by Koutlakis and Lane are unsuitable for agitating and milling because of clumping.

Thus, there is no motivation to combine these references with the references disclosing agitating media (including, but not limited to, Blanton or Rosenflanz) because the intended purpose of Koutlakis and/or Lane is to form blasting material. As taught in the Koutlakis Declaration, making the polysaccharide particle larger renders it unsuitable for blasting. The MPEP states that where a modification renders the composition unsuitable for its intended purpose there can be no motivation to combine the references. Thus, there is no motivation to combine the cited references. As further supported in the Koutlakis Declaration, those of ordinary skill in the art would not be otherwise motivated to make such modifications. Thus, because there is no

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teaching, suggestion, or motivation to combine these references, Applicants respectfully request that all of the obviousness rejections (I-III) be withdrawn as to all claims.

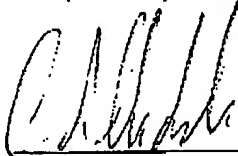
CONCLUSION

For at least the reasons discussed above, Applicants respectfully request reconsideration of the rejections of the claims. Applicants believe that these claims define over the prior art of record and are in proper form for allowance. In accordance, Applicants respectfully request allowance of the claims.

If the undersigned can be of assistance to the Examiner regarding any of the above, please contact the undersigned at the number set forth below.

4/24/06
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Respectfully submitted,



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